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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,946	04/16/2001	KRISTOFER E. ELBING	KEE-0014	7924

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KRISTOFER E. ELBING  
187 PELHAM ISLAND ROAD  
WAYLAND, MA 01778

EXAMINER
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SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 12/09/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.  
**09/835,946**

Applicant(s)  
**Elbing et al**

Examiner  
**Steve Sax**

Art Unit  
**2174**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims\***

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_                      6) ☐ Other:

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### DETAILED ACTION

1. This application has been examined. This application is a continuation of S.N. 09/028069, filed 2/23/1998 and now U.S. Patent 6219034.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21, 27, 29, 31-34, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg et al (5880714) and Keyson (6046726).

4. Regarding claim 21, see in Rosenberg et al the computer system with processor and operating system and display (Figure 1, 2A, column 3 lines 10-20 ), the pointing device with position sensor having an output line and tactile actuator having an input line (column 3 lines 22-32, column 4 lines 25-46), wherein the input line is responsive to the pointing device driver which is in turn responsive to the output line (column 4 lines 40-55, column 6 lines 40-50), an application responsive to the pointing device driver and operating system and communicating

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with the display, and wherein the driver is responsive to a general purpose application (column 5 lines 1-22 and 33-42, abstract). Rosenberg et al do not go into the details of plural applications, with a plurality of application specific profile elements for the applications that define tactile signals to the actuator when interacting with the corresponding applications, but do show the application responsive to the driver and defining tactile signals to an actuator application for efficient user feedback (aforecited, also column 8 lines 1-11). Furthermore, Keyson shows the plurality of applications, and with the specific profile elements for applications that define tactile signals to the actuator when interacting with the corresponding applications (column 2 lines 1-17, column 3 lines 1-18, column 4 lines 1-5) for efficient user feedback. It would have been obvious to a person with ordinary skill in the art to have this in Rosenberg et al because it would provide efficient user feedback.

5. Regarding claim 27, the application specific profile elements in Keyson correspond to one of the applications (column 4 lines 1-5).

6. Regarding claim 29, the system has an operating system interface elements to define signals to the actuator when interacting with the operating system (Rosenberg et al column 5 lines 1-22).

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7. Regarding claims 31-32, Rosenberg et al show using a convenient input device for a user to hold. Keyson shows the pointing device may be a mouse with housing, the transducer is in the housing, and the position sensor is in the mouse, and the actuator is the mouse pad (column 3 lines 24-33). It would have been obvious to a person to use this arrangement in Rosenberg et al, because it would be a convenient pointing device for a user to hold.

8. Regarding claim 33, Keyson mentions in column 3 lines 24-33 possibilities which inherently include a touch pad, and the obviousness to have this follows as in paragraph 7 of this Office Action.

9. Claims 34 and 40 show the same features as claim 21 and are rejected for the same reasons. Note that multiple actuation commands and applications with specific profile elements in claim 21 would correspond with the first and second commands and applications in claim 34.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer: A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 21-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6219034. Although the conflicting claims are not identical, they are not patentably distinct from each other because both show the computer processor, operating system, position sensor with output line, tactile actuator with input line, pointing device driver responsive to output line of the position sensor and input line of actuator responsive to pointing device driver, plurality of applications responsive to the pointing device driver to the operating system and in communication with the display, the pointing device driver responsive to the general applications, and plurality of application specific profile elements for applications that define tactile signals to be sent to the

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actuator when interacting with the application. The claims are generally broader than those of the '034 patent.

12. Any inquiry concerning this communication should be directed to Steve Sax at telephone number (703) 305-9582.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Sax whose telephone number is (703) 305-9582. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306

Official Communication

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
STEVEN SAX  
PRIMARY EXAMINER